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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,303	10/04/2006	Mario Leclerc	BRKP:012US/10602032	3382
33425 7590 12/05/2011 FULBRIGHT & JAWORSKI L.L.P. 98 SAN JACINTO BOULEVARD SUITE 1100 AUSTIN, TX 78701-4255				
EXAMINER YOUNG, SHAWQUITA				
ART UNIT		PAPER NUMBER		
1626				
NOTIFICATION DATE		DELIVERY MODE		
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/568,303

Filing Date: October 4, 2006

Appellant(s): LECLERC ET AL.

\_\_\_\_\_  
Michael R. Krawzsenek  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed September 16, 2011 appealing from the Office action mailed November 17, 2010.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After non-Final**

The examiner has no comment on the appellant's statement of the status of amendments after non-final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being

maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

**(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

**(8) Grounds of Rejection**

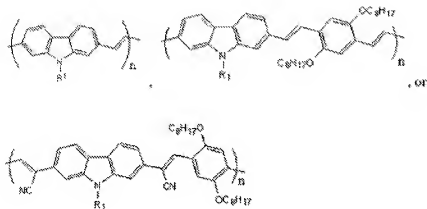
The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

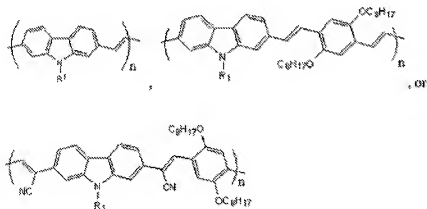
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 76, 77, 80, 81, 83, 84, and 106 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have added new claim 106 which contains the following limitation "wherein the polymer comprises the following structure



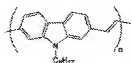
, wherein n=5-100" in the amendment filed by

Applicants on June 1, 2010 but this limitation is not disclosed in the original specification and is considered new matter because the amendment introduces subject matter that is not supported by the original disclosure. The original specification does not disclose polymers comprising the following structures



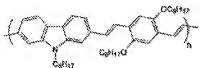
, wherein n=5-100 and variable R<sup>1</sup> is as defined in

claim 106. Applicants' specification does have support for a polymer having the

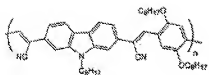


structure

(see page 7, paragraph 0028),



(see page 7, paragraph 0030) or



(see page 8, paragraph 0032) wherein n is an integer

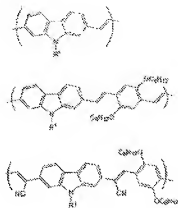
ranging from 5 to 100. Applicants are suggested to delete the added above limitation which is considered new matter and amend the claims to read on subject matter that is supported by the originally filed disclosure.

#### **(10) Response to Arguments**

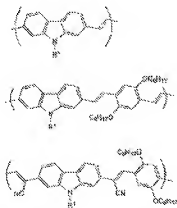
##### **Rejection of claims 76, 77, 80, 81, 83, 84 and 106 under 35 USC 112, first paragraph for lack of written description**

Appellants argue that to satisfy the written description requirement, the specification must reasonably convey to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. The analysis requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Furthermore, the written description requirement does not demand any particular form of disclosure or that the specification recite the claimed invention in haec verba. Applicants further argue that a person of skilled in the art would conclude that the inventors were in possession of the polymers recited in claim

However, the Examiner wants to point out that applicants do have support for a polymer comprising monomeric units of the structure



The Examiner also wants to point out that the definition of "polymer" that Applicants have referred to in their arguments also clearly states that it is to be understood that the polymers as described herein may be composed of different monomeric units. There is no support present in the originally filed specification that Applicants' intended invention is drawn specifically to a polymer that has 5-100 monomeric units of the structure



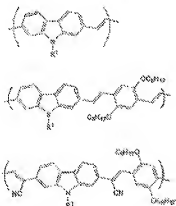
wherein R<sup>1</sup> is as defined in claim 106 bonded

together in a chain as indicated in claim 106. The Examiner wants to reemphasize that the definition of the term "polymer" as indicated in the specification states that the polymer may be composed of different monomeric units so what would lead one of

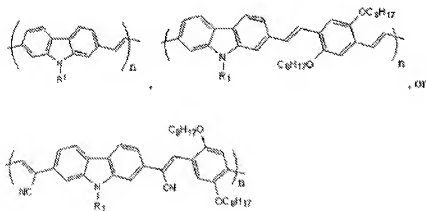


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ordinary skill in the art to the instantly claimed invention in claim 106 instead of a polymer that contains a monomeric unit selected from one of the structures



wherein the above monomeric unit is bonded to a completely different monomeric unit. Applicants have chosen this subgenus formula without any support in the specification that these polymers have been prepared and intended as the claimed invention. Therefore in light of the originally filed specification, the Examiner maintains the position that the limitation of polymers comprising the following structures



wherein  $n=5-100$  and variable  $R^1$  is as defined in

claim 106 is considered new matter because there is no support present in the original

specification that would lead one of ordinary skill in the art that the instant invention of claim 106 was prepared and intended as the claimed invention at the time of filing.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,  
/Shawquia Young/

November 30, 2011

Conferees:

/Joseph K. McKane/

**Supervisory Patent Examiner, Art Unit 1626**

/Brandon Fetterolf/

**Supervisory Patent Examiner, Art Unit 1628**